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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,630	06/27/2003	Per Martinsson	930010-2206	8456
20/999 7590 03/09/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER PIZIALI, ANDREW T	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 03/09/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,630

Applicant(s)

MARTINSSON ET AL.

Examiner

Andrew T. Piziali

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 7-12, 14, 15, 17, 19, 21-26, 28-45, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) 5, 7-12, 19, 21-26 and 29-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 14, 15, 17, 28, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Supplemental Reply

1. The supplemental reply filed on 3/3/2009 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). The reply filed 1/9/2009 has already been considered and a suspension of action was not requested by the applicant in the RCE filed 1/9/2009. Supplemental replies will not be entered as a matter of right, except when a supplemental reply is filed within a suspended period under 37 CFR 1.103 (a) or (c) (e.g., a suspension of action requested by the applicant when filing an RCE).

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/9/2009 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. It is noted that the applicant failed to indicate specific support for the new claim in the response filed 1/9/2009. The specification does not appear to mention the fabric not being prone to the claimed failure. Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the phrase “the papermaking fabric is not prone to substantially immanent failure at the point at which the core yarns are revealed” renders the claim indefinite. It is not clear how susceptible a fabric must be to read or not read on said limitation.

Secondly, there is insufficient antecedent basis for the limitation “the point at which the core yarns are revealed.”

Thirdly, the phrase “selected from the group consisting essentially of” renders the claim indefinite. It is not clear if the fabric construction is necessarily selected from the claimed members.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 14, 15, 17, 28, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,093,512 to Fleischer in view of any one of USPN 3,800,019 to Parsey or USPN 6,653,943 to Lamb.

Fleischer discloses a papermaking fabric multilayer load bearing coated yarn comprising a multilayer resin sheath (see entire document including column 4, lines 22-50). Fleischer discloses that the load bearing yarn may be a monofilament (column 3, lines 40-46).

Regarding the monofilament being formed before being used in a papermaking fabric, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an

unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Fleischer does not appear to specifically disclose that the layers of the resin sheath are visibly distinguishable from one another and the core by contrasting color or reflectivity, but Fleischer does disclose that yarns are subject to abrasion and wear (column 1, line 41 through column 2, line 50). Parsey and Lamb each disclose that it is known in the wear detecting yarn art that a core may be surrounded by a plurality of outer layers of different colors to indicate the degree of wear (see entire documents including column 2, lines 8-29 of Parsey and column 4, lines 20-35 of Lamb). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the multilayer resin sheath of the monofilament of Fleischer with a plurality of outer resin layers of different colors from one another and the core, motivated by a desire to allow for the indication of the degree of wear.

If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. One must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. **KSR v. Teleflex**

Regarding claims 3 and 17, considering that the core and sheath layers are different colors, the indicated level of fabric wear is associated with a wear level through the respective layers.

Regarding claims 14 and 28, Fleischer discloses that a filament wrapping or cover material may be applied to the load bearing coated yarn (column 4, lines 22-36). Therefore, the filament may comprise some or all of a multifilament yarn (Figures 3, 5, 7 and 9).

Regarding claim 15, Fleischer discloses that the load bearing coated yarn may be used to construct an endless industrial fabric (column 3, lines 31-37).

Regarding claim 49, Fleischer discloses that the fabric may be woven (column 3, lines 27-56).

9. Claims 1, 3, 14, 15, 17, 28, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,093,512 to Fleischer in view of Applicant's Disclosure in view of any one of USPN 3,800,019 to Parsey or USPN 6,653,943 to Lamb.

Fleischer discloses a papermaking fabric multilayer load bearing coated yarn comprising a multilayer resin sheath (see entire document including column 4, lines 22-50). Fleischer discloses that the load bearing yarn may be a monofilament (column 3, lines 40-46).

Regarding the monofilament being formed before being used in a papermaking fabric, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Fleischer does not appear to specifically disclose that the layers of the resin sheath are visibly distinguishable from one another and the core by contrasting color or reflectivity, but Fleischer does disclose that yarns are subject to abrasion and wear (column 1, line 41 through column 2, line 50). In addition, the current Applicant discloses that a means for monitoring wear on a papermaker's fabric, and particularly at any point on its inner and outer surfaces, even when the paper machine is operating, would be very helpful to those in the papermaking industry (page 3, lines 7-12).

Parsey and Lamb each disclose that it is known in the wear detecting yarn art that a core may be surrounded by a plurality of outer layers of different colors to indicate the degree of wear (see entire documents including column 2, lines 8-29 of Parsey and column 4, lines 20-35 of Lamb). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the multilayer resin sheath of the monofilament of Fleischer with a plurality of outer resin layers of different colors from one another and the core, motivated by a desire to allow for the indication of the degree of wear.

If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. One must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. **KSR v. Teleflex**

Regarding claims 3 and 17, considering that the core and sheath layers are different colors, the indicated level of fabric wear is associated with a wear level through the respective layers.

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Response to Arguments

10. Applicant's arguments filed 1/9/2009 have been fully considered but they are not persuasive.

The applicant asserts that Fleischer does not teach or suggest coating the monofilament before the monofilament is used in the papermaking fabric. The applicant asserts that the fabric is coated, rather than each monofilament. The examiner respectfully disagrees. Fleischer clearly

illustrates the monofilaments as being individually coated with a sheath of resin material. See Figure 7 wherein the resin sheath (18) coats the yarn (16). In addition, Fleischer specifically states that the yarns (16) have been coated with the resin (18) (column 4, lines 22-36).

The applicant asserts that there is no motivation to combine the references. The examiner respectfully disagrees. Fleischer does not appear to specifically disclose that the layers of the resin sheath are visibly distinguishable from one another and the core by contrasting color or reflectivity, but Fleischer does disclose that the yarns are subject to abrasion and wear (column 1, line 41 through column 2, line 50). Parsey and Lamb each disclose that it is known in the abrasion and wear yarn art that a core may be surrounded by a plurality of outer layers of different colors to indicate the degree of wear (see entire documents including column 2, lines 8-29 of Parsey and column 4, lines 20-35 of Lamb). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the multilayer resin sheath of the monofilament of Fleischer with a plurality of outer resin layers of different colors from one another and the core, motivated by a desire to allow for the indication of the degree of wear.

The applicant asserts that one of ordinary skill in the art would not look to elevator suspension ropes to come up with a solution for the instant problem. The examiner respectfully disagrees. Firstly, Parsey does not strictly relate to elevator suspension ropes. Rather, Parsey specifically discloses that the invention relates to all ropes of high stretch resistance comprising a sheath (column 1, lines 4-7). It is noted that Fleischer completely relates to ropes of high stretch resistance comprising a sheath. Secondly, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her

skill. One must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. **KSR v. Teleflex.**

The applicant asserts that the examiner employs hindsight reasoning to provide motivation to combine references and cites page 5 of the Final office action mailed 5/28/2008 which cites the current specification on page 3, lines 7-12. The examiner respectfully disagrees. Firstly, as indicated above, all the claims are first rejected without citation to the current disclosure. Secondly, the section of the current specification that is cited in the second rejection is that which appears on page 3, lines 7-12 under the "Background of the Invention" section.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/
Primary Examiner, Art Unit 1794